

### **REMARKS**

This responds to the Office Action mailed on March 2, 2009.

Claims 1, 6, 9-10, 17, 22-26 and 31-34 are amended, no claims are canceled or added; as a result, claims 1-34 remain pending in this application. Applicant has amended the claims to clarify that a gaming element is a “displayable gaming element” such as a card from a set of cards, a die or any other output symbol that is displayed as part of a wagering game outcome. Support for the amendment may be found throughout the specification, and at least on pages 5-6 and in Appendix A of the specification. Applicant respectfully submits that no new matter has been introduced with the amendments.

### **Interview Summary**

Applicant thanks Examiner Jeffrey Wong and Supervising Primary Examiner John Hotaling for the courtesy of a telephone interview on June 11, 2009 with Applicant's representatives Rodney L. Lacy and Scott Schulhof. A discussion of the differences between the cited references and Applicant's claims was held. In particular, differences between the operation of scripts (as the term is used in Boyd) to portion out a bonus amount in response to a predetermined outcome was discussed. Examiner Wong stated that the term “game element” was interpreted to include game input mechanisms in addition to output elements such as cards, dice etc. It was agreed that further consideration of the claims would be required in response to claim amendments related to the “game element.”

### **§ 103 Rejection of the Claims**

Claims 1-3, 6-7, 9-19, 22-23, 25-28, 31 and 34 were rejected under 35 U.S.C. § 103(a) as being obvious over Boyd (U.S. Publication No. 2004/0214628). The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct.

684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

Applicant's claims recite elements not found in Boyd, as a result, there are differences between the claims at issue and Boyd. For example, claims 1 and 26 as amended recite "receiving during the runtime of a wagering game a game rules script, the game rules script comprising text specifying a set of displayable game elements for a wagering game, the text further defining one or more rules to determine a set of one or more winning outcomes in terms of one or more of the set of displayable game elements." Claims 10 and 17 recite similar language with respect to a game rules script. Applicant respectfully submits that Boyd does not disclose a script defining rules to determine a set of one or more winning outcomes in terms of one or more of the set of displayable game elements. As noted in the Office Action, Boyd discloses what is referred to as a script at paragraph [0072], which states that "the scripts are preferably stored, selected, and operated within the gaming machine electronics 94, such scripts can be stored, selected, and operated across the gaming machine network." However, Applicant respectfully submits that the scripts in Boyd are very different from the scripts recited in Applicant's claims and do not include the attributes recited in the claims. For example, it is clear

from Table 2 and the discussion in paragraphs [0080] to [0088] that at best, the scripts in Boyd merely operate to apportion out a predetermined bonus amount in a series of steps, where the number of steps is defined by the script and where a step is demarcated by a user input. However, there is absolutely no disclosure in Boyd that the scripts define any rules using displayable game elements such as cards, dice etc., nor is there any disclosure in Boyd that the rules for a winning outcome are defined in the script. None of the scripts shown in Table 1 or Table 2 show any displayable game elements such as card or dice symbols, nor do the scripts in Boyd refer to displayable game elements of any sort.

Additionally, claims 1 and 26 recite “determining if the game outcome matches at least one winning outcome in the set of winning outcomes in accordance with the game rules data structure.” Claims 10 and 17 recite similar language with respect to determining winning outcomes. The Office Action cites paragraph [0010] as teaching the recited language. Applicant respectfully disagrees with this interpretation of Boyd. Paragraph [0010] states “A plurality of bonus scripts operable on the gaming machine during the bonus mode are stored within a memory coupled to the processor with each bonus script being associated with a particular end bonus award value” (emphasis added). In other words, the particular bonus award value is predetermined within the selected script. There is no disclosure in paragraph [0010] of Boyd or in any other portion of Boyd that a script defines rules that are parsed into a data structure and used to determine whether the outcome generated on a gaming machine is a winning outcome. The only thing defined in the scripts of Boyd is how many steps are used to apportion the bonus amount, and how much of the bonus to apportion at each step.

In view of the above, there are multiple elements of Applicant’s claims 1, 10, 17 and 26 that are not taught or suggested in Boyd. In view of these differences, claims 1, 10, 17 and 26 are not obvious in view of Boyd. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 10, 17 and 26.

Claims 2-3, 6-7, and 9 depend from claim 1; claims 11-16 depend from claim 10; claims 18-19, 22-23 and 25 depend from claim 17; and claims 27-28, 31 and 34 depend from claim 26. These dependent claims inherit the elements of their respective base claims and are therefore allowable for at least the same reasons as discussed above regarding their respective base claims.

Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 2-3, 6-7, 9, 11-16, 18-19, 22-23, 25, 27-28, 31 and 34.

Additionally, claims 9, 25 and 34 recite elements of a specific method for determining if a match exists according to match rules. With respect to claims 9 and 25, the Office Action merely refers to Boyd's paragraph [0004] and states "It is well known in the art that there are many methods in which video poker can be played." While it may be true that many methods exist to play video poker, Boyd does not teach or suggest any specific method, and in particular, Boyd does not teach the elements of claims 9, 25 and 34. Nothing in paragraph [0004] or any other part of Boyd discloses any algorithm or method for evaluating matches for a set of game elements and match rules. Paragraph [0004] does not disclose a method of any kind, rather paragraph [0004] provides a general description of a casino environment and casino games. Because none of the operations of the method recited in claims 9, 25 and 34 are taught or suggested by Boyd, claims 9, 25 and 34 are not obvious in view of Boyd.

Claims 4, 5, 8, 20, 21, 24, 29, 30 and 33 were rejected under 35 U.S.C. § 103(a) as being obvious over Boyd (U.S. Publication No. 2004/0214628) in view of Perrie et al. (U.S. Publication No. 2002/0036380).

Each of claims 4-5, 8, 20-21, 24, 29-30 and 33 depends from a claim that recites a game rules script where the game rules script comprises "text defining a set of displayable game elements for a wagering game, the text further including a set of winning outcomes for a game, each of the set of winning outcomes including a set of match rules expressed in terms of the set of displayable game elements." As discussed above, Boyd does not teach or suggest a games rules script where the script defines the displayable game elements and rules for a wagering game using the displayable game elements, nor does Boyd teach or suggest determining if the game outcome matches at least one winning outcome in the set of winning outcomes in accordance with the game rules data structure. Applicant has reviewed Perrie and can find no teaching or suggestion of a game rules script or using the game rules script to determine winning outcomes. As a result, the combination of Boyd and Perrie fails to teach or suggest each and every element of Applicant's claims 4-5, 8, 20-21, 24, 29-30 and 33. Therefore there are differences between the cited references and the claims at issue. As a result, claims 4-5, 8, 20-21, 24, 29-30 and 33 are not obvious in view of the combination of Boyd and Perrie. Applicant

respectfully requests reconsideration and the withdrawal of the rejection of claims 4-5, 8, 20-21, 24, 29-30 and 33.

### **CONCLUSION**

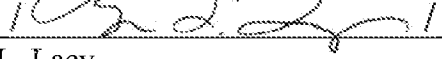
Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' representative at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date July 2, 2009

By   
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 2nd day of July, 2009.

Rodney L. Lacy

Name

Signature

